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RESPONSE UNDER 37 CFR § 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP
Docket No.: 1614.1024

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Yuji KUMAKURA

Serial No. 09/488,019

Group Art Unit: 2122

Confirmation No. 3839

Filed: January 20, 2000

Examiner: Chuck O. Kendall

For: INFORMATION PROCESSOR, METHOD FOR PROCESSING INFORMATION AND
COMPUTER-READABLE RECORDING MEDIUM RECORDED WITH PROGRAM
CODE FOR CONTROLLING A COMPUTER TO PROCESS INFORMATION

RESPONSE TO FINAL OFFICE ACTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Attention: **BOX AF**

Sir:

Introduction

This is in response to the Final Office Action that was mailed on September 16, 2003, which has a period for response that is set to expire on December 16, 2003.

The following amendments and remarks are respectfully submitted. Reconsideration of the claims is respectfully requested.

In the Office Action that was mailed on September 16, 2003, claims 1-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Stupek, Jr. et al. (U.S. Patent No. 5,586,304) ("Stupek") in view of Kullick et al. (U.S. Patent No. 5,764,992) ("Kullick"). The foregoing rejections are respectfully traversed.

Claims 1-27 are pending in the subject application, of which claims 1, 10, and 19 are independent claims.

Claimed Invention

Independent claims 1, 10, and 19 of the subject application recite "deleting all information stored at the current address including the program."

Cited References

The examiner stated that Stupek does not specifically disclose deleting the program. (Office Action, p. 3) However, the examiner cited Kullick as disclosing the same.

Kullick discusses a basic network that includes a server 10 and multiple client computers 12. (Kullick, Figure 1) The local memories 16 of the client computers 12 store various software programs that run on the client computers 12. (Kullick, col. 3, lines 18-20) Over time, as the software programs are updated by their developers, the client computers 12 need to have their current versions replaced with the updated versions. (Kullick, col. 3, lines 24-31) Therefore, upgraded versions of the software are stored in shared memory area 14 on server 10. (Kullick, col. 3, lines 36-38) Upon launching a software application, each client computer 12 checks whether a newer version of the software is available from shared memory area 14 on server 10, and if so, client computer 12 downloads the newer version into its area 20 of its local memory 16. (Kullick, col. 3, lines 38-45; col. 4, lines 61-63) The older version of the software application, formerly stored in area 20 of local memory 16, is then moved to area 22 of local memory 16. (Kullick, col. 4, line 59; col. 5, lines 4-6) Upon the application being launched again, older versions thereof are deleted from area 22 of local memory 16 of the client computers 12. (Kullick, col. 5, lines 8-10)

Lack Of Motivation To Combine The References

The examiner did not supply the requisite motivation to combine Stupek and Kullick. Specifically, the examiner did not point to any evidence in either reference that suggests that the teachings therein should be combined or modified.

MPEP § 706.02(j) sets forth the contents of a rejection under § 103: "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some

suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure" (emphasis in original).

MPEP § 2142 states that "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper." The Examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." Dembiczak, 50 USPQ2d at 1617. "The factual inquiry whether to combine the references must be thorough and searching." In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (citing McGinley v. Franklin Sports, Inc., 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). The factual inquiry must be based on objective evidence of record, and cannot be based on subjective belief and unknown authority. Id. at 1433-34. The Examiner must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

The Examiner has not presented any evidence why Stupek and Kullick would have been combined. The mere fact that references can be combined or modified (see the Applicant's further arguments against combination below) does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.01. Specifically, there must be a suggestion or motivation in the references to make the combination or modification. Id. The Examiner's sole support for such a combination is that "deleting outdated or previously used programs ensures better program management, hence eliminating potential software conflict." (Office Action, p. 3) The Examiner cannot rely on the benefit of the combination without first supporting the motivation to make the combination. Such motivation does not appear anywhere in either reference, and the Examiner has not

presented any actual evidence in support of the same. Instead, the Examiner relies on broad conclusory statements, subjective belief, and unknown authority. Such a basis does not adequately support the combination of references; therefore, the combination is improper and must be withdrawn.

Stupek And Kullick Cannot Be Combined

Even if the examiner did present the requisite motivation to combine the references (see arguments thereto above), the references cannot be combined. Specifically, contrary to the examiner's conclusion in the Office Action, someone skilled in the art would not be motivated to combine the references in order to "[delete] outdated or previously used programs [to ensure] better program management, hence eliminating potential software conflict," because Kullick specifically provides for several scenarios in which multiple versions of the same software application can concurrently exist on the client computer 12 (Kullick, col. 3, line 63 – col. 4, line 3; col. 4, lines 23-28; col. 5, lines 13-16). Therefore, someone of ordinary skill in the art would not read Stupek in view of Kullick and arrive at the claimed invention, because Stupek and Kullick are not able to be combined in this regard. Without the required motivation to combine Stupek and Kullick, the § 103(a) rejections must be withdrawn.

Conclusion

Withdrawal of the foregoing rejections is respectfully requested.


There being no further objections or rejections, it is submitted that the application is in condition for allowance, which action is courteously requested. Finally, if there are any formal matters remaining after this response, the examiner is requested to telephone the undersigned

to attend to these matters. If there are any additional fees associated with filing of this Response, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 11-18-2003

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